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APR 2 4 2006

Patent
Attorney's Docket No. P209

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of)	Mail Stop AF
)	
Richard Robinson, et al.)	Group Art Unit: 2178
)	
Application No.: 09/728,785)	Examiner: Gregory J. Vaughn
)	
Filed: November 30, 2000)	Confirmation No.: 2704
)	
For: Metadata Internet Platform For Enabling)	
Customization of Tags in Digital Images)	

FACSIMILE COVER SHEET

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

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PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) *P209*

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	First Named Inventor *Richard Robinson*	
	Art Unit *2178*	Examiner *Gregory Vaughn*

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
    Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number _52,809_

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

John A. Demos
Signature
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Telephone number
April 24, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.
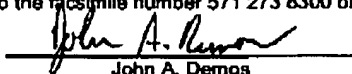
☐ *Total of _____ forms are submitted.

Patent
Attorney's Docket No. P209/1938P

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:

Richard Robinson, et al.

Application No.: 09/728,785

Filed: November 30, 2000

For: Metadata Internet Platform For
Enabling Customization Of Tags In
Digital Images

Mail Stop: AF
Expedited Procedures Requested

Group Art Unit: 2178

Examiner: Gregory J. Vaughn

Confirmation No.: 2704

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection of claims 1-32 in the subject application. No amendments are being filed with this Request.

This Request is being filed with a Notice of Appeal.

Background

Claims 1-32 are pending in the present application, of which claims 1, 10, 16, and 25 are presented in independent form. Claims 1-32 stand finally rejected.

Independent claims 1, 10, and 16 stand finally rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent 6,445,460 (filed 4/13/1998, patented 9/3/2002) to Pavley (hereinafter "Pavley"). Independent claim 25 stands finally rejected under 35 U.S.C. 103(a) as being unpatentable over Pavley in view of U.S. Patent 6,581,094 to

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Gao (hereinafter "Gao"). The claims were finally rejected in a second final office action (paper 120) mailed December 23, 2005. The reasons for the rejection were clarified by an advisory action (paper 150) mailed March 15, 2006, and further clarified by a second Examiner's interview summary (paper 155) mailed March 29, 2006.

The method, computer readable medium, and system as recited in the independent claims of the instant application include storing a key ID and a definition on a server. The definition alters a first pre-defined function of an image tag to create a custom tag having a second pre-defined function that is different from the first pre-defined function. A plurality of image files are received, each including image data, the key ID, and the one or more custom tags containing data. The image files are automatically recognized by the key ID and the corresponding stored definition is used to extract the data from the one or more custom tags to make the data available to a user along with the image data.

Reasons for Request

The record fails to address the recitation in the claims of using the key ID and corresponding stored definition to extract data from the tags. In addition, the record is unclear as to what elements of Pavley the recited key ID and corresponding definition stored on a server for altering a first pre-defined function of an image tag read on.

1. The Office has failed to address the recited feature of extracting data from one or more custom tags in its rejections of independent claims 1, 10, 16 and 25.

Nowhere in the record does the Office address, much less provide support for, whether Pavley describes the specific recitation in the independent claims of automatically recognizing image files by a key ID and using a definition stored on a server corresponding to the key ID to extract data from one or more custom tags. Instead, the Office only states that Pavley's server describes providing for automatic image file handling for a digital image capture device (see, e.g., paper 20, page 13; paper 110, page 6; paper 120, page 14; and paper 150, page 2) or that Pavley stores raw image

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data in a frame buffer for display on an LCD screen (see paper 20, page 13). The claimed invention is not directed to image file handling or the displaying of raw image data, rather, it is directed to the extraction of data from one or more custom tags. Applicants respectfully assert that the record is silent regarding this feature because the feature is neither explicitly nor inherently described by Pavley.

As set forth in MPEP § 2131, "to anticipate a claim, the reference must teach every element of the claim." The various rejections of independent claims 1, 10, 16, and 25 during prosecution does not establish in the record where Pavley teaches automatically recognizing the image files by the key ID and using the corresponding stored definition to extract the data from the one or more custom tags, as recited in the rejected claims. Accordingly, the record does not provide an appropriate basis to proceed with an appeal for at least this reason.

2. The record is unclear as to what elements of Pavley the recited key ID and corresponding definition stored on a server for altering a first pre-defined function of an image tag read on.

In the first final action, the Examiner asserts that the recited key ID reads on a "number of the image" in Pavley's arrangement (see paper 20, page 12) and that the recited corresponding definition apparently reads on Pavley's ruleset (see paper 20, page 5—although no relation between the claimed features and the cited portion is provided.) The non-final and final actions mailed after the filing of Applicants' Request for Continued Examination appear to indicate that both the recited key ID and corresponding definition are stored in the Pavley's image file (see paper 110, page 5, and paper 120, page 6.) Yet in these same actions, the Examiner also appears to assert that the recited corresponding definition reads on Pavley's rulesets. The advisory action then states that the header of Pavley's image preferably includes information that identifies (key ID) and describes (definition) the various contents of image file 835 (see paper 150, page 2, last paragraph.) Moreover, the second interview summary states that Pavley's rule set,

embodied as a rule document, would inherently include rules and rule identifiers (see paper 155)—apparently asserting that Applicants' key ID reads on such an inherent rule identifier. The record is thus confusing (at least to Applicants) as to what elements, if any, of Pavley's arrangement the recited key ID and definition are asserted to read upon.

Regardless of the confusing record, it should be clear that if the recited definition is asserted to be included in the header of Pavley's image file (as papers 110, 120, and 150 appear to assert), Pavley does not reach the claimed invention, as the independent claims require that the definition and its corresponding key ID be stored on the server. If the key ID were to read on Pavley's image number, or any other information included in the header of the image file, Pavley would not reach the claimed invention, as a definition file corresponding to such an image number or other header information for altering the pre-defined function of an image tag to create a custom tag having a second function is not stored on the server and used to extract data from one or more custom tags. If an inherently described rule identifier is said to anticipate Applicants' key ID, then such a rule identifier must also be found in a received image file as a key ID to reach the claimed invention. The Applicants respectfully disagree that Pavley inherently describes any such rule identifier and, in any event, assert that Pavley does not disclose storing a rule identifier corresponding to one of its rulesets in the header of its image files.

Indeed, nowhere does Pavley describe the cooperation of elements of Applicants' key ID and corresponding definition stored on a server for altering the pre-defined function of an image tag to create a custom tag having a second function and used to extract data from one or more custom tags. Fig. 7 of Pavley illustrates the manner in which Pavley's ruleset functions. Pavley describes at column 6, lines 25-32, that a rule document is selected in step 1200. Once the rule set is selected, the file attribute is then examined in step 1202. Since the file attribute is examined after the rule document has been selected, the file attribute disclosed in Pavley cannot function

as the key ID of the instant claims. The claims require the image files be recognized by the key ID and the corresponding stored definition be used to extract data from the custom tags of the image file according to the definition. As such, Pavley can not be said to disclose a key ID as claimed in the independent claims.

Accordingly, the unclear manner in which Pavley has been applied to support the various rejections of independent claims 1, 10, 16, and 25, in addition to the Office's failure to clearly identify where Pavley teaches Applicant's key ID and corresponding definition stored on the server for extracting data from one or more custom tags has further resulted in a record that does not provide an appropriate basis to proceed with an appeal.
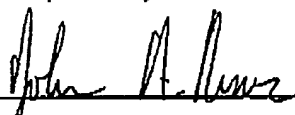
Summary

As stated above, the record fails to address the recitation in the claims of using the key ID and corresponding stored definition to extract data from the tags. The record is also unclear as to what elements of Pavley the recited key ID and corresponding definition stored on a server for altering a first pre-defined function of an image tag read on. Moreover, Applicants respectfully assert that these features are absent from the cited documents. Accordingly, the rejection of independent claims 1, 10, 16, and 25 should be withdrawn and the application should be passed to issue.

Respectfully submitted,

Date: <u>April 24, 2006</u>   By: _____

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